

Atty. Docket No.: Q76146
PATENT APPLICATION

RESPONSE UNDER 37 C.F.R. § 1.1116
U.S. Application No.: 10/612,968

REMARKS

Claims 21 – 25 and 30 are presently pending.

I. 35 U.S.C. § 103 Rejection of Claims 21, 23, 25 and 30 in View of JP 57-6974 to Kimura

For the reasons that follow this rejection is respectfully traversed.

Independent Claim 21

The Examiner concedes in the present Office Action that the Kimura reference is deficient at least as to those features of Applicant's claim 21 included in the "wherein" clause. The Examiner first alleges that Applicant's "wherein" clause merely states results of the limitations in the claims and adds nothing to the claim "because the mark alone can not define a transport direction." The Examiner also appears to allege that claim 21 is rejected under 35 U.S.C. § 112, first paragraph, for allegedly not including a scanner and decoder. These allegations are discussed in turn, below.

The Examiner cites to case law as allegedly supporting the position that Applicant's wherein clause is not to be provided any patentable weight (*citing Texas Instruments v. International Trade Commission*, 988 F.2d 1165 (Fed. Cir. 1993) and *Griffin v. Bertina*, 285 F.3d 1029 (Fed. Cir. 2002)). With respect, Applicant submits that the Examiner either misinterprets the cited case law, fails to comprehend the language in Applicant's wherein clause, or both. The cases cited by the Examiner prove that the Examiner's position is not in accordance with the law, and that the rejection constitutes an administrative determination that is arbitrary and capricious.

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Texas Instruments and *Griffin* both stand for the principle of claim interpretation that a "wherein" clause *should* be granted patentable weight *unless* what is recited in the noted clause is merely a reiteration of prior limitations¹ or solely a necessary result of those features preceding the clause (*see Texas Instruments* at 1171-72 and *Griffin* at 1033-34). Stated differently, a wherein clause is accorded patentable weight when it includes additional features beyond those already recited. *Id.*

Applicant's wherein clause includes the additional feature, not found elsewhere in the claim, namely:

said first mark defines a transport direction to said printing device.

The foregoing feature appears nowhere else in the claim, and is not solely a necessary result of the previously recited features. Accordingly, Applicant's wherein clause is valid under precedent set forth by the Federal Circuit (including *Texas Instruments* and *Griffin*). The Examiner is therefore respectfully requested to reconsider and to withdraw this rejection because the Examiner has no legal basis for failing to give patentable weight to the express limitations of the claim, and further because at least the features set forth in Applicant's wherein clause are absent from, and not suggested by, the Kimura reference.

The Examiner also appears to make a 35 U.S.C. § 112, first paragraph, rejection of claim 21 for not reciting a scanner and decoder. Applicant believes that perhaps the Examiner meant

¹ If the limitations were already stated elsewhere in the claim, then the limitations have already been given patentable weight.

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to refer to M.P.E.P. § 2172.01 and its discussion of unclaimed essential matter. In any event, the Examiner's own statement explains why claim 21 does not *need* to recite a scanner and/or a decoder.

The Examiner states that “[o]ne of ordinary skill in the art would realize that marks require scanning and decoding which is not recited in Claim 21.” Applicant respectfully asserts that if the ordinarily skilled artisan would realize that a scanner and/or a decoder are inherent to the practice of the invention, those features do not need to be recited by the claim. Indeed, in an exemplary embodiment, Applicant’s mark is shown in Figure 9(a) as element 110, and is discussed in the paragraph bridging pages 34 and 35. Therein it states that “the transport direction determination section 48 determines the transport direction of the bag 86 [from having read the mark 110].”

Those of ordinary skill in the art (even those of little skill in the art) readily comprehend that the mark 110 is read, and the information thus obtained is used to determine a transport direction for the bag. The skilled artisan understands the metes and bounds of Applicant’s invention.

For example, while Applicant’s invention also includes a structural casing of some sort, and discrete electronic components to carry out the function of the invention recited by the claims, these features do not need to be explicitly recited in the claims for the invention to be understood with clarity and precision (*see* M.P.E.P. § 2173.02). Indeed, the true test is whether Applicant’s description would enable the person of ordinary skill to make and use the invention; there is no requirement that the description provide such enablement to a rank beginner in the

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field, or one unfamiliar with the field. Since Applicant's description is written to the level of the artisan of ordinary skill, and since the artisan of ordinary skill would "realize that marks require scanning and decoding," and because scanning and decoding are now an ancient and well-developed technology made familiar to the entire population,² the claim is respectfully submitted to be fully enabled in the originally-filed specification. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw this rejection.

Furthermore, Applicant asserts that claims 22 – 24 are patentable at least by virtue of their dependency on claim 21.

Independent Claim 25

Claim 25 sets forth the features of a "folded portion (116) disposed on said second surface". At least these features are absent in the Kimura reference.

Applicant's folded portion 116, as claimed, is disposed on the surface that is opposite to the first surface recorded by the print head 56. According to this structure, the possibility of the print head 56 becoming obstructed by the bag 86 is greatly reduced.

In comparison, Kimura does not disclose a folded portion. Kimura merely discloses a standard bag for holding photographed film or negatives, without a folded portion 116. While the Examiner attached minuscule drawings from the Kimura patent as allegedly showing a folded

² Every product purchased today includes a UPC symbol, and every store uses scanners to read these symbols, and every in-store point of sale terminal decodes these UPC symbols into item and price information. Nobody in this country is unfamiliar with scanning and decoding, let alone the artisan of ordinary skill.

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portion, enlarged views of the same drawings clearly reflect that Kimura's depicted bag is not drawings clearly folded. Indeed, if Kimura's bag were folded at the end suggested by the Examiner, the bag would not be capable of being opened to insert the merchantable items recited by Applicant's claims.

The Examiner is therefore respectfully requested to reconsider and withdraw this rejection. Furthermore, Applicant asserts that patentability of claim 30 at least by virtue of its dependency upon claim 25.

II. Rejection of Claims 22 and 24 Under 35 U.S.C. § 103 in View of Kimura and WO 99/49408 to Buinevicius

As noted above in Part I, Kimura is deficient in teaching or suggesting certain features of Applicant's claims. The Buinevicius reference perpetuates these deficiencies. Accordingly, the Examiner is respectfully requested to reconsider and withdraw this rejection.

III. Conclusion

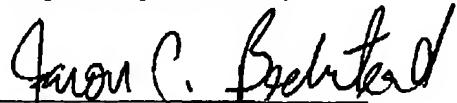
In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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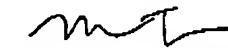
Respectfully submitted,



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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this RESPONSE UNDER 37 C.F.R. § 1.116 is being facsimile transmitted to the U.S. Patent and Trademark Office this 25th day of February, 2005.



Mariann Tam

Date: February 25, 2005

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